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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,270	01/10/2002	Mark Serpa	60036-0011	7845

25989 7590 06/08/2004

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EXAMINER

CHEN, RANDALL E

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/044,270	SERPA, MARK
Examiner	Art Unit
Randall Chin	1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other.

DETAILED ACTION

1. Consistent terminology should be used with respect to the "means for extracting" as recited in claim 17. Specifically, claims 17, 18, 20 and 21 also recite "extraction means". It is suggested to change "extraction means" to "extracting means"—in all occurrences for consistency.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 12, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Brookhart '635.

Brookhart '635 teaches a tool for scraping or cleaning a tube comprising a body or manual grasping means (Fig. 2), a tip which can serve as an extraction tip extending outwardly from the body wherein the tip is dimensioned to have a length approximately equal to that of an intake cavity or is sized to fit in the intake cavity (merely relative), and has a plurality of barbs or "sharpened fluted edges" (Fig. 2) formed in the tip and capable of catching matter in an intake cavity and withdrawing matter from an intake cavity following insertion. The tip is deemed to be a "drill" or "drill bit" fixed in the body. Typically, it is noted that a "drill" usually is associated with some type of rotating means for the "drill." Clearly, the claims do not require any such structure.

As for the tool being used to clean a watercraft speedometer, it has been held that with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and merely involves intended use. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The recitation that the tip has a length approximately equal to that of the intake cavity also involves intended use and also would be merely relative depending on the size of a cavity to be cleaned.

4. Claims 11-14, 17, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sauer '888.

Sauer '888 teaches a tool for scraping or cleaning a tube comprising a body or manual grasping means 21, a tip 60 (Fig. 5) which can serve as an extraction tip extending outwardly from the body wherein the tip is dimensioned to have a length approximately equal to that of an intake cavity or is sized to fit in the intake cavity (merely relative) and has a plurality of "sharpened fluted edges" formed in the tip and capable of catching matter in the intake cavity following insertion, and a securable and removable closure or cap 34 for covering the "drill" (Figs. 2 and 4). The tip is deemed to be a "drill" or "drill bit" fixed in the body. Typically, it is noted that a "drill" usually is associated with some type of rotating means for the "drill." Clearly, the claims do not require any such structure.

As for the tool being used to clean a watercraft speedometer, it has been held that with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and merely involves intended use. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The recitation that the tip has a length approximately equal to that of the intake cavity also involves intended use and also would be merely relative depending on the size of a cavity to be cleaned.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15, 16, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer '888 in view of Borst '240.

Sauer '888 teaches all of the recited subject matter as set forth above with the exception of the closure having a plurality of female threads that mate with corresponding male threads formed on the body and the body having a hole for accepting a flotation device. Borst '240 discloses a closure 10 having a plurality of female threads that mate with corresponding male threads 17 formed on the body and a hole 19. It would have been obvious to one of ordinary skill in the art to have provided

Sauer's closure with a plurality of female threads that mate with corresponding male threads formed on the body for the purpose of providing a secure attachment of the closure to body and to avoid loss of the closure and to have a hole on the body as suggested by Borst '240 for accepting a floatation device therethrough.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer '888 in view of Borst '240 as applied to claim 22 above, and further in view of Field '593.

Field '593 teaches a hole 13 in a closure. It would have been obvious to one of ordinary skill to have provided the modified Sauer device with a hole in the closure as suggested by Field '593 for accepting some type of floatation device therethrough.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer '888 in view of Borst '240 and Field '593.

Sauer '888 teaches all of the recited subject matter as set forth above with the exception of the closure having a plurality of female threads that mate with corresponding male threads formed on the body and the body having a hole that would be able to accept a floatation device.

Borst '240 discloses a closure 10 having a plurality of female threads that mate with corresponding male threads 17 formed on the body and a hole 19.

Field '593 teaches a hole 13 in a closure.

It would have been obvious to one of ordinary skill in the art to have provided Sauer's closure with a plurality of female threads that mate with corresponding male

threads formed on the body for the purpose of providing a secure attachment of the closure to body and to avoid loss of the closure as suggested by Borst and to have further provided a hole on the body as suggested by Field '593 for accepting a floatation device.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 11, 12, 14, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kiefer '370.

Kiefer '370 teaches a tool comprising a body or manual grasping means 20 (Fig. 1) and a threaded shank 24 which can serve as a "means for extracting matter" and thus as an "extraction tip" extending outwardly from the body wherein the tip 24 is dimensioned to have a length approximately equal to that of an intake cavity or is sized to fit in the intake cavity (merely relative), and has a plurality of "sharpened fluted edges" (Fig. 1) formed in the tip and capable of catching matter in an intake cavity and withdrawing matter from an intake cavity following insertion. The tip 24 is deemed to be a "drill" or "drill bit" fixed in the body. Typically, it is noted that a "drill" usually is associated with some type of rotating means for the "drill." Clearly, the claims do not require any such structure. Kiefer's tool can clearly function as a "cleaning" tool.

As for the tool being used to clean a watercraft speedometer, it has been held that with respect to the manner in which a claimed apparatus is intended to be

employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and merely involves intended use. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The recitation that the tip has a length approximately equal to that of the intake cavity also involves intended use and also would be merely relative depending on the size of a cavity to be cleaned.

10. Applicant's arguments filed May 20, 2004 have been fully considered but they are not persuasive.

Applicant argues that the structure of a "drill bit" is characterized by spiral cutting flutes on a cylindrical body and not as shown by Sauer '888 or Brookhart '635. The Examiner respectfully disagrees here. It is the Examiner's position that there could be various types of "bits" that could well be used for some type of "drilling" function. Assuming Applicant's position was correct, then the recitation in claim 18 reciting that the drill bit "further comprises a plurality of sharpened fluted edges" would be somewhat redundant since claim 17 already claims a "drill bit" structure if Applicant asserts that a "drill bit" must be characterized by "spiral cutting flutes on a cylindrical body." Thus, all of Applicant's arguments based on "drill bit" structure and the applied Prior Art have been considered but are deemed unpersuasive. Furthermore, it should be noted that any existing drill available on the market that has a drill bit attached thereto would be sufficient to reject, for example, claim 11 since claim 11 is merely claiming a "manually graspable body element" which is simply a handle and a "drill bit." The fact that the

Art Unit: 1744

preamble recites a "tool for cleaning a watercraft speedometer" is patentably irrelevant for purposes of rejecting claim 11, for example. Intended use is merely involved here and cited case law has been included above. Applicant should note that the claims are not reciting a "method for cleaning a watercraft speedometer."

As for the combination of references based on the 35USC103 rejection, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Sauer '888, Borst '240 and Field '593 are all deemed analogous in the hand-held cleaning tool art.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stewart '379 teaches a drilling arrangement.

12. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

Art Unit: 1744

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Robert Warden, can be reached at (571) 272-1281. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



R. Chin



Randall Chin
Primary Examiner
Art Unit 1744